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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/732,120
	Filing Date	12/07/2000
	First Named Inventor	Radosavljevic
	Group Art Unit	2833
	Examiner Name	Luebke, Renee S.
	Attorney Docket Number	905-124

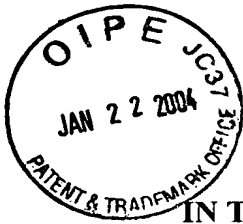
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Firm and Individual name	Wall Marjama & Bilinski, LLP Daniel P. Malley Reg. No. 43,443
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Typed or printed name	Kathryn A. Watson	
Signature		Date January 20, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Radosavljevic et al.

Serial No: 09/732,120

Filing Date: 12/07/2000


Title: SLIDE SWITCH FOR FAN  
CONTROL

Group Art Unit: 2833

Examiner: Luebke, Renee S.

**RESPONSE**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail addressed to Mail Stop: Reply Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 20, 2004.

  
Kathryn A. Watson

Attention: Board of Patent Appeals and Interferences  
Assistant Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

**REPLY BRIEF**

Pursuant to 37 C.F.R. § 1.193, Appellants hereby reply to the new points of argument raised in the Examiner's Answer (Answer) dated November 20, 2004. You are hereby authorized to charge deposit account No. 50-0289 for any other necessary fees.

**NEW POINTS OF ARGUMENT RAISED IN ANSWER AND APPELLANTS' REPLY**

**1. Examiner's New Point of Argument:**

On page 2 of the Answer, in paragraph 5, the Examiner argues that the Appellants Summary of Invention is only "substantially correct." In particular, the Examiner states that "there is no disclosure (or claim) that 'resistor-capacitor (RC) circuit is also mounted

on circuit board 15. Nor is there any disclosure that the RC network and all other components are interconnected by electrical traces disposed in and on circuit board 15.’ ”

**Appellants’ Reply:**

The Appellants respectfully disagree. Presumably, the Examiner makes this argument because of the need to be consistent with her idiosyncratic definition of what a circuit board is. As pointed out repeatedly by the Appellants, everyone of ordinary skill in the art knows what a circuit board is. Further, no one of ordinary skill in the art would make a differentiation between a “circuit board” and a “printed circuit board.” These terms are synonymous and further, the Examiner has failed to point to any evidence in the body of knowledge generally available to those of ordinary skill in the art in support of her idiosyncratic definition of a circuit board. Having said that, the Appellants now point to the disclosure that shows an RC circuit and other components being interconnected on circuit board 15.

Circuit board 15 is shown in Figure 1. Figure 1 also shows a resistor mounted on the circuit board. Figure 5 shows two rows of contacts 22 mounted on circuit board 15. The text states that the labeling in Figure 5 “corresponds to the schematic of Fig. 6.” Figure 6 is a schematic that shows both RC circuits and other components being electrically connected. Taken together, the RC circuits and other components in the schematic are, in fact, disposed on the circuit board 15. Further, the disclosure does not have to explicitly describe the traces in the circuit board because it is well settled that a patent need not teach, and preferably omits, what is known in the art. *Spectra-Physics, Inc. v. Coherent, Inc.*, 3 USPQ2d 1737 (Fed. Cir. 1987). The use of traces to interconnect components disposed on a circuit board is known in the art. What is not known in the art, is the combination of features recited in the claims.

**2. Examiner’s New Point of Argument**

On page 4 of the Answer, the Examiner argues that her description of bottom plate 10d as a circuit board is not a mis-identification. The Examiner states “Appellant argues that since Takano does not call the structure a circuit board, then it cannot be one.

This is merely a matter of semantics. The name that one patentee chooses to give a structure does not eliminate other names for the structure.”

**Appellant’s Reply:**

The Appellants respectfully disagree with the Examiner. The Appellants are not relying on semantics. The Appellants are relying on the plain language of the specification. As pointed out in Appellants’ Brief, the inventor states that reference numeral 10d is a bottom plate, and not a circuit board. On the other hand, it appears as if the Examiner is using semantics when she asserts that: “the member is a board and it supports portions (i.e. contacts and leads) of a circuit. It is therefore a circuit board.”

Appellants make the following observations. First of all, semantically speaking, a board is a rigid piece of flat wood. Element 10d is not a rigid piece of flat wood, therefore, it is not a board. Second, while the Appellants agree that element 10d is used for support, it does not make it a circuit board because it does not electrically interconnect any components. Finally, the Appellants respectfully point out that the best person to know what a component is, in this case element 10d, is the inventor, not the Examiner. Takano calls element 10d a bottom plate and teaches that bottom plate 10d is a part of housing 10. Col. 4, lines 17 – 22. The Examiner’s attempt to pass off plate 10d as a circuit board strains credulity.

In the Appeal Brief, the Appellants pointed out that the Examiner attempts to give a meaning to the term “circuit board” that is repugnant to the usual and ordinary meaning of the term.

**3. Examiner’s New Point of Argument**

On page 4 of the Answer, the Examiner argues that conductors 22 are circuit board “traces.”

**Appellant’s Reply:**

Appellants again respectfully point out that the inventor identifies elements 22 as being contact strips. Appellants also respectfully point out that Figure 1 and Figure 6 do not portray elements 22 as circuit board traces. Instead, they look like what the patentee says they are, namely, contact strips. Further, they cannot be traces because they do not interconnect anything on plate 10d, which the Examiner mistakenly identifies as a circuit board.

#### **4. Examiner's New Point of Argument**

The Examiner attempts to refute the Appellants' observation that Takano lacks circuitry by stating that "a circuit is merely a means of transmitting electrical signals from one place to another."

#### **Appellant's Reply:**

Appellants respectfully point out that the Examiner's definition is not accurate. In fact, the Examiner provides a definition for a transmission line. A circuit is, in fact, a closed path that may be traversed by an electric current. The closed path typically includes a configuration of electrical components, such as resistors, capacitors, inductors, or solid state devices. Referring to Figure 1 and Figure 6, and all the associated text, Takano does not include a circuit of any kind.

#### **5. Examiner's New Point of Argument**

The Examiner states that Appellants have not indicated any claimed limitation that is not met by the device shown by Takano.

#### **Appellant's Reply:**

The Appellants respectfully disagree. As evidenced by the above arguments and the arguments provided in the Appeal Brief, Appellants have shown that Takano does not disclose the circuit board as recited by claim 1. Appellants have shown that Takano does not disclose a slide switch for a circuit disposed on a circuit board, as recited in claim 1. Appellants have shown that Takano does not disclose a plurality of contacts mounted on

a circuit board, as recited in claim 1. Finally, Appellants have shown that Takano does not disclose a glider housing for disposition on a circuit board, as recited by claim 1.

Accordingly, the Applicants respectfully assert that claim 1 is patentable under 35 U.S.C. § 102(b) because the Examiner has failed to point out where Takano discloses the claimed invention. Claim 2 is patentable at least by virtue of its dependency from claim 1.

#### **6. Examiner's New Point of Argument**

In response to Appellants' pointing to established precedent, i.e., that "the PTO may not properly combine prior art references in order to establish *prima facie* obviousness unless there is some suggestion for doing so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," the Examiner argues that "contrary to appellants' assertion that the examiner must point to where the prior art suggests the desirability of combining references, the motivation for combination may also be found in knowledge available to the general public."

#### **Appellants' Reply:**

Appellants respectfully request that the Examiner point to at least one body of knowledge generally available to those of ordinary skill in the art in support for her assertions. The point the Appellants made in the Appeal Brief is that the Examiner cannot point to any portion of the cited references or to any body of knowledge generally available to those of ordinary skill in the art in support for her assertions. On the other hand, the Appellants pointed out that the combination was improper because the proposed modification changes the principle of operation of the prior art invention being modified, and because the proposed modification renders the prior art unsatisfactory for its intended purpose. The Examiner did not respond to these arguments.

#### **6. Examiner's New Point of Argument**

The Examiner repeatedly states that each of the features recited in the claims are well known.

**Appellants' Reply:**

The Appellants respond by noting that while the Examiner asserts that each of the features recited in the claims are well known, she provides no evidence to back her assertions. Appellants have shown that Takano does not disclose each element of independent claim 1. Appellants have also pointed out that the Hanna reference does not supply the claim elements missing from Takano. Further, the Examiner has failed to point out where Hanna teaches the all of the limitations of claims 5 or 6. Claim 5 specifically recites all of the terminal connections of the claimed switch. For example, one claim element states that "said switch having a second position where an electrical connection is made between said first and second terminals through a first capacitance." The Examiner has failed to point out where this limitation, and the other limitations in claim 5 can be found in the cited references. Claim 6 has similar limitations. The Examiner has also failed to point out where these limitations can be found. Instead, the Examiner merely states that Hanna includes a RC circuit. As pointed out repeatedly, this is not enough to sustain a rejection under 35 U.S.C. §103(a).

**7. Examiner's New Point of Argument**

The Examiner provides PTO provided boilerplate to refute Appellants' arguments that she is engaging in improper hindsight. However, the Examiner does not answer the crux of Appellants' arguments.

**Appellants' Reply:**

The Appellants pointed out in the Appeal Brief that the Examiner, with the claims in mind, has selected and joined isolated parts of the references to assert that Applicant's invention would have been obvious. Appellants further pointed out that one of ordinary skill in the art would not replace Takano's bus bar arrangement with discrete terminals because Takano is specifically directed to bus bar type switches. Col. 1, lines 10 – 15. Further, because Takano is directed to a simple switch having no internal circuits, one of ordinary skill in the art would not seek to incorporate the RC network of Hanna in

Takano. Clearly, the Examiner is using impermissible hindsight to assert that the present invention is obvious in light of the combined references by selecting and joining isolated parts of the references to assert Applicant's invention would have been obvious. The Examiner does not answer these arguments.

#### **8. Examiner's New Point of Argument**

With regard to the Appellants' argument that the proposed combination does not have a reasonable expectation of success, the Examiner repeats her assertion that "all of the features are well known." Thus, she argues, "there is no reason not to expect success in combining these features." The Examiner also states that "applicant has not shown that one of ordinary skill would have difficulty combining the references.

#### **Appellants' Reply:**

Quite to the contrary, Appellants respectfully point out that the Appeal Brief provided reasons why there was no reasonable expectation of success, and why one of ordinary skill would have difficulty combining the references. Specifically, the Appellants pointed out that the Examiner has failed to show how Takano could reasonably accommodate the proposed modifications. In particular, the Appellants pointed out that the Examiner had failed to show how Takano could function suitably if the RC network of Hanna were included in Takano. Because RC networks are designed with certain circuits or features in mind, it is at best, improbable that the RC network of Hanna would have the right electrical properties relative to the Takano invention. Further, the contact arrangement in Hanna would not be a suitable replacement for the bus bars used in Takano. The replacement arrangement would not work unless Takano were re-designed into something that would not be recognized as being Takano's switch. The Examiner does not answer these pointed arguments.



In view of the foregoing, and additionally for the reasons set forth in the appellant's Appeal Brief, the final rejection of the claims should be reversed.

Respectfully submitted,

Date:

1/26/09

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